

Appl. No. 10/654,990  
Amendment dated: October 12, 2005  
Reply to OA of: July 12, 2005

### **REMARKS**

Applicants have amended the claims in order to more particularly define the scope of the invention. Claims 1 and 5 have been amended to recite that the connection portions extend horizontally across the entire side of the restoration tooth to which they extend from. These amendments are fully supported by the specification, including, e.g., Figure 14. Applicants most respectfully submit that all the claims now present in the application are in full compliance with 35 U.S.C. §112 and are clearly patentable over the references of record.

The rejection of claims 3 and 7 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter has been carefully considered but is most respectfully traversed in view of the following comments

The Official Action urges that "[t]he grant of limited, but exclusive property right in a human being is prohibited by the Constitution" and cites *In re Wakefield*, 422 F.2d 897 (CCPA 1970) in support of this statement. Applicants note that no portion of *In re Wakefield* addresses the issue of patenting a human being or even 35 U.S.C. §101 in general. In *Wakefield*, the CCPA reviewed the rejection of product claims for synthetic polyisoprene having essentially the molecular structure of natural Hevea rubber. In doing so, the CCPA addressed issues such as antedating affidavits and multiplicity of claims, but did not address 35 U.S.C. §101 or the patenting of human beings.

In any event, Applicants assert that claims 3 and 7 do not claim human beings as prohibited by the Constitution. Rather, claims 3 and 7 recite that the connection portions are attached to a projection of the side of teeth adjoining a restored tooth. Applicants fail to see how this is the same as claiming a human being and therefore respectfully request that the §101 rejection be withdrawn.

The rejection of claims 1, 3 and 4 under 35 U.S.C. §102(b) as being anticipated by Hruska and claims 5, 7 and 8 as being anticipated by Wismann each has been carefully considered but is most respectfully traversed in view of the amendments to the claims and the following comments.

Appl. No. 10/654,990  
Amendment dated: October 12, 2005  
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Applicant wishes to direct the Examiner's attention to MPEP § 2131 which states that to anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed.Cir. 1990).

The presently amended claims recite a restoration tooth wherein connecting portions horizontally extend across the entire side of the restoration tooth from which they extend. This is most clearly illustrated by Figure 14 of the present application. Figure 14 shows connecting portion 44', which extends horizontally across the entire side of the restoration tooth 40' from which it extends. As described in the specification, the present invention aims to eliminate the gap formed between the top edge of the restoration tooth of the present invention and the top edge of a healthy tooth adjoining the restoration tooth. The elimination of this gap has a soothing effect on chewing and can serve to prevent the deposition of food particles in tooth gaps that cannot easily be removed by means of ordinary oral hygiene. These results are achieved when the connection portions horizontally extend across the entire side of the restoration tooth from which it extends.

The Official Action urges that Hruska anticipates the invention of the present application, including a detachable restoration tooth 1 comprising a bottom provided with a cavity extending into the interior of the tooth, an outer surface having a boundary edge in relation to the bottom, a top having two boundary edges in relation to the outer surface, and wherein the top is provided with two connection portions 2, each extending

from one of the two boundary edges. However, Hruska clearly fails to disclose a connecting portion that horizontally extends across the entire side of the restoration tooth from which it extends as claimed in the presently amended application.

Applicants note that the connection portions 2 of Hruska are called "jointing tabs" in the specification and are welded together with a corresponding jointing tab extending from an adjacent crown so as to connect adjacent crowns or bridges. As shown in Figures 1 and 2, for example, the jointing tabs are narrow and slender and do not extend horizontally across the entire portion of the tooth from which they extend. Rather, the jointing tabs are positioned in a predominantly vertical position and are narrower than the side of the tooth from which they extend. This is so that adjoining jointing tabs can be paired and welded together as shown in Figure 2.

Therefore, because Hruska fails to disclose a connecting portion which horizontally extends across the entire side of the restoration tooth from which it extends as claimed in the present application, the reference cannot properly support a §102(b) rejection as set forth in MPEP §2131. Accordingly, Applicants respectfully request that this rejection be withdrawn.

With respect to Wismann, the Official Action urges that the reference anticipates the presently claimed invention, including a detachable restoration tooth comprising a bottom provided in one side with a cavity extending into the interior of the tooth and an other side with a protruded portion, an outer surface having a boundary edge in relation to the bottom, a top having two boundary edges in relation to the outer surface, and wherein the top is provided with two connection portions, each extending from one of the two boundary edges. Applicants note that, while not explicitly identified as such in the Official Action, reference numeral 90 of Figures 9 and 10 appears to be relied upon as disclosing the connection portions.

As can most clearly be seen in Figure 10, which is a cross section of the tooth shown in Figure 9, the connection portion 90 is circular in cross-section and does not extend across the entire side of the tooth 88 from which it extends. Rather, the connectors 90 of Wismann are rod shaped and are smaller in cross sectional diameter

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than the side of the tooth from which it extends. Therefore, because Wismann fails to disclose a connecting portion which horizontally extends across the entire side of the restoration tooth from which it extends as claimed in the present application, the reference cannot properly support a §102(b) rejection as set forth in MPEP §2131. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Also, Applicants note that the present claims recite two connection portions for being attached to the top of a tooth adjoining the restored tooth. This is clearly illustrated by, e.g., Figures 9, 12 and 13 of the present application. The connection portion (44 in Figure 9 and 54 in Figures 12 and 13) is shaped so as to rest on top of the adjoining tooth for easy attachment. This design prevents the formation of a gap between the top of the two adjoining teeth and provides for a soothing effect on chewing.

To the contrary, Hruska clearly shows a jointing tab 2 that does not attach to the top of an adjoining tooth. Rather, the jointing tabs disclosed in Hruska are aligned vertically so as to fit together at the sides of the two adjoining teeth with no portion of the jointing tabs extending over the top of the adjoining tooth. As can be seen in, e.g., Figures 4 and 11 of Hruska, the top of the jointing tabs are substantially lower than the tops of the adjoining teeth and therefore do not meet this limitation of the presently amended claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.


Wismann also fails to disclose connection portions for being attached to the top of a tooth adjoining the restored tooth. As discussed above and as can be seen in Figures 9 and 10 of the reference, the connection portion disclosed in Wismann is a rod-shaped extension that protrudes from the middle of the side of the tooth from which it extends. The connection portion is substantially lower than the top of the adjoining tooth and therefore does not meet all the limitations of the present invention. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Appl. No. 10/654,990  
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In view of the above comments and further amendments to the drawings and claims, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

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